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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

F-190

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on September 8, 2005Signature Amy HarveyTyped or printed name Amy Harvey

Application Number

09/650,177

Filed

August 29, 2000

First Named Inventor

Robert A. Cordery

Art Unit

3621

Examiner

C. Hewitt II

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☐ attorney or agent of record.
Registration number _____☒ attorney or agent acting under 37 CFR 1.34.Registration number if acting under 37 CFR 1.34 43,748

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September 8, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Claims 35 and 37 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action contends that the method as recited in claim 35 is broad enough to read on a method where the register lacks sufficient funds and the steps of sending, receiving, deducting and activating do not take place, and concludes from this that the claims fail to particularly point out and distinctly claim the subject matter regarded as the invention.

The primary purpose of the requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). Applicants respectfully submit that the claims clearly apprise one of ordinary skill in the art of its scope and that the metes and bounds of the claims are easily interpreted so as to understand how to avoid infringement. The Office Action is attempting to improperly read unclaimed limitations into the claim. The scope of the claims is clear as to what constitutes infringement of the claims. The claims do not read on how the method is to perform if the register lacks sufficient funds, nor do they need to. The scope of the claim is directed to the steps performed if the register does contain sufficient funds. As stated in the MPEP, section 2173.04, if the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second

paragraph. Applicants respectfully submit that the claims are not indefinite as stated above and are in full compliance with 35 U.S.C. 112.

Claims 35 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fisher (U.S. Patent No. 5,005,200) in view of Taylor (U.S. Patent No. 5,530,232). Fischer is directed to a public key cryptographic system with enhanced digital signature certification that authenticates the identity of the public key holder. Specifically, in Fischer, a trusted authority creates a digital message which contains the claimant's public key and the name of the claimant and a representative of the authority signs the digital message with the authority's own digital signature. This digital message, often referred to as a certificate, is sent along with the use of the claimant's own digital signature. Any recipient of the claimant's message can trust the signature, provided that the recipient recognizes the authority's public key. (Col. 3, lines 53-64). The system of Fischer provides the ability to specify a variety of attributes associated with the certification, such as specifying the authority or constraints which are conferred on the certifier by the certifier. (Col. 4, lines 56-62). Thus, while Fischer discloses the use of certificates for providing security functions, there is no disclosure, teaching or suggestion in Fischer of "receiving at a metering device a request for a cryptographic certificate, the metering device including a register having funds stored therein, determining if sufficient funds are present in the register for obtaining the certificate, if sufficient funds are present in the register, generating, at the metering device, a cryptographic key pair including a private key and a public key" as is recited in claim 35. There is also no disclosure, teaching or suggestion in Fischer of "deducting funds from the register for obtaining the requested certificate; and in response to funds being deducted from the register, activating the private key of the cryptographic key pair" as is recited in claim 35. In Fisher, the public and private keys are generated and activated at the same time. Claim 35, in contrast, specifically recites that the key pair is generated if there are sufficient funds present in the register, but the private key of the key pair is not activated until after the funds have been deducted from the register.

To overcome some of the above deficiencies the Office Action relies on the reference to Taylor. Taylor is directed to a multi-application data card capable of substituting for a plurality

of existing single-application data cards. The data card 10 is formed of plastic and contains solid state circuitry 12 having a microprocessor and memory chips. The memory chips hold the equivalent of several typewritten pages of information related to different applications. One application of the card is as a cash card with a stored cash value, thereby avoiding the need to purchase traveler's checks. Thus, if Taylor teaches anything at all, it is merely a single credit/debit card that can be used for multiple accounts. There is no disclosure, teaching or suggestion in Taylor of "receiving at a metering device a request for a cryptographic certificate . . . determining if sufficient funds are present in the register for obtaining the certificate, if sufficient funds are present in the register, generating, at the metering device, a cryptographic key pair including a private key and a public key; sending a certificate request to a certificate authority, the certificate request including the public key of the cryptographic key pair; receiving a cryptographic certificate from the certificate authority, the cryptographic certificate including the public key of the cryptographic key pair generated by the metering device; deducting funds from the register for obtaining the requested certificate; and in response to funds being deducted from the register, activating the private key of the cryptographic key pair" as is recited in claim 35.

There is no disclosure in Fisher or Taylor, either alone or in combination, of "receiving at a metering device a request for a cryptographic certificate, the metering device including a register having funds stored therein . . . determining if sufficient funds are present in the register for obtaining the certificate, if sufficient funds are present in the register, generating, at the metering device, a cryptographic key pair including a private key and a public key; sending a certificate request to a certificate authority, the certificate request including the public key of the cryptographic key pair; receiving a cryptographic certificate from the certificate authority, the cryptographic certificate including the public key of the cryptographic key pair generated by the metering device; deducting funds from the register for obtaining the requested certificate; and in response to funds being deducted from the register, activating the private key of the cryptographic key pair" as is recited in claim 35.

The Office Action contends that it would have been obvious to combine the teachings of Fisher and Taylor to allow a user to protect user financial information while making a purchase over an insecure network. The Office Action has not provided any indication as to where such a suggestion is provided in the prior art. The fact that the present invention was made by the Applicant does not make the present invention obvious; that suggestion or teaching must come from the prior art. See C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998). See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051-1052 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so.)

Even if, for arguments sake, one was motivated to combine the teachings of Fisher and Taylor, it still does not arrive at the present invention. There is no disclosure, teaching or suggestion in either of the references, either alone or in combination, of “determining if sufficient funds are present in the register for obtaining the certificate, if sufficient funds are present in the register, generating, at the metering device, a cryptographic key pair including a private key and a public key; sending a certificate request to a certificate authority, the certificate request including the public key of the cryptographic key pair; receiving a cryptographic certificate from the certificate authority, the cryptographic certificate including the public key of the cryptographic key pair generated by the metering device; deducting funds from the register for obtaining the requested certificate; and in response to funds being deducted from the register, activating the private key of the cryptographic key pair” as is recited in claim 35. As noted above, in Fisher the cryptographic key pair are generated and activated at the same time. This is not the same as in the present invention, in which the key pair is generated and the private key activated at different times. Without using the present claims as a road map, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from these references. The rejection uses impermissible hindsight to reconstruct the present invention from this reference. See Ex parte Clapp, 227 U.S.P.Q. 972,973 (Bd. App. 1985) (requiring “convincing line of reasoning” to support and obviousness determination).